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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,790	02/09/2006	Hironobu Nagoh	1691-0215PUS1	2691
2292 7590 09/21/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER BERNSHTEYN, MICHAEL				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/21/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/567,790

Applicant(s)

NAGOH ET AL.

Examiner

MICHAEL M. BERNSTEYN

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action follows a response filed on May 19, 2009. No claims have been amended, cancelled or added.
2. Claims 1-5 are pending.

Claim Rejections - 35 USC § 103

3. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Momoda et al. (U.S. Patent Application Publication 2005/0263745 or WO 01/05854) in view of Chen et al. (WO 99/38924), for rationale recited in paragraph 5 of Office Action dated February 19, 2009 and comments below.

Response to Arguments

5. Applicant's arguments, see remarks, filed May 19, 2009, with respect to double patenting rejection and the rejections of claims 1-5 under 35 U.S.C. 102(b) as being anticipated independently by Momoda et al. (U.S. Patent Application Publication 20030036579), Momota et al. (JP 2003-128713), and Kadowaki (WO 02/93236 or U.S. Patent Application Publication 2004/0109133) have been fully considered and are persuasive. The rejections of claims 1-5 under 35 U.S.C. 102(b) have been withdrawn.
6. Applicant's arguments filed on May 19, 2009 with respect to the rejection of claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Momoda et al. (U.S.

Patent Application Publication 2005/0263745 or WO 01/05854) in view of Chen et al. (WO 99/38924) have been fully considered but they are not persuasive.

7. It appears that the focal Applicants argument resides in the contention that there is no rational underpinning to support the legal conclusion of obviousness, since the rejections include an improper combination of references (page 8, 1st paragraph) because a radical non-polymerizable silyl compound cannot function as the adhesion monomer in the composition of Momoda'745; thus, the teachings of these references cannot be combined (page 8, 3rd paragraph).

8. In response to applicant's argument that one of ordinary skill in the art would not be motivated to modify the teachings of these two cited references, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that WO'924 is nonanalogous art because the polymerization-curing mechanism in the coating composition disclosed in WO'942 is a polymerization-curing mechanism using a so-called "polythiol-polyene reaction" by application of light., and in the coating composition of WO '924, therefore, the radical non-polymerizable silyl compound has reactivity to a polyol, and hence works as a monomer; however, this compound does not have a radical-polymerizable group, and thus would not work as a monomer in the curable composition of Momoda'745 (page 8, 4th paragraph; page 9, 1st paragraph), it has been held that a prior art reference must

either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references clearly belong to the same field of endeavor concerning curable compositions comprising photochromic compounds.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., polymerization-curing mechanism, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, since the claimed silanol or silanol-yielding compounds are known to be useful within photochromic compositions at the time of invention, one would have been motivated to utilize them for their art recognized function as taught by Chen within the photochromic compositions of Momoda. It has been held that it is *prima facie* obvious to utilize a known compound for its art recognized function. *In re Linder*, 173 USPQ 356. *In re Dial* et al., 140 USPQ 244.

9. Applicants contend that it is evident that WO '924 regards both of these two types of compounds as having the same function. In contrast, in the present invention, the "radical non-polymerizable silyl compound" and the "radical-polymerizable silyl compound" are clearly distinguished, and even if a "radical-polymerizable silyl

compound" is used, the effect of the present invention cannot be obtained without also using a "radical non-polymerizable silyl compound," as presently claimed. WO '924 does not teach or suggest the use of both, or the superior and unexpected results obtained by doing so (page 9, 2nd paragraph).

10. It is noted that Chen (WO'924) discloses that the adhesion promoting comonomer may be selected from **any one or more** of the following compounds, wherein the majority of the compounds are silicon compounds having no radically polymerizable group (page 28, lines 2-32).

Furthermore, Chen exemplifies in many examples (Examples 1-12) the usage of the silicon compound having no radically polymerizable group, such as

3- mercaptopropyltrimethoxysilane (page 28, line 26).

Thus, the obtained results cannot be considered as unexpected results because the usage of silicon compounds i having no radically polymerizable group such as 3-mercaptopropyltrimethoxysilane, etc. in the curable compositions for forming a photochromic coating layer is well known in the art (see also Mogami et al. U. S. patent 4,556,605).

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/

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Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796

/David Wu/
Supervisory Patent Examiner, Art Unit 1796